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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/626,617 07/27/00 DUMOUTIER L LUD 5664 US

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HM22/0420

EXAMINER

DECLoux, A

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SEE ID NO 43 A A Humm

Office Action Summary

Application No.
09/616,617

Applicant(s)

Dumoutier

Examiner

DeCloux, Amy

Group Art Unit

1644



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-21 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-21 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-12, drawn to a method for stimulating expression of a STAT transcription factor and for inducing production of an acute phase protein in a cell comprising contacting a cell capable of said expression with an IL-TIF/IL-21, classified in Class 424, subclass 184.1,

II. Claims 13-19, drawn to a method for modulating activity of an IL-TIF/IL-21 molecule, comprising contacting a cell susceptible to IL-TIF/IL-21 activity with an IL-TIF/IL-21 modulator, classified in Class 424, subclass 278.1,

III. Claim 20, drawn to a method for determining exposure to an inflammatory substance, classified Class 435, subclass 7.24, or

IV. Claim 21, drawn to a method for identifying a modulator of IL-TIF/IL-21, classified in Class 435, subclass 7.21,

Note: Claim 16 depends on itself. For examination purposes, claim 16 is being interpreted as depending on claim 13. Applicant is required to clarify.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-IV are unique methods. They differ with respect to ingredients, process steps and/or endpoints. Therefore, they are patentably distinct each from the other.

3. Because Inventions I-IV are distinct for the reasons given above, and they have acquired a separate status in the art because the searches of the non patent literature are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

4. If Group I is elected, the applicant is further required under 35 U.S.C. 121,
 - A) To elect a method comprising a **specific STAT transcription factor**, such as STAT 3 or STAT 1 as recited in claim 2,
 - B) To elect a method comprising a **specific IL-TIF/IL-21**, such as human IL-TIF/IL-21 as recited in claims 5 and 11.
 - C) To elect a method comprising a **specific acute phase protein**, such as human serum amyloid A, α 1 chymotrypsin, or haptoglobin as recited in claim 9,
 - D) To elect a method comprising a **specific cell**, such as liver cell, as recited in claim 8,
5. If Group II is elected, the applicant is further required,
 - A) To elect a method comprising a **specific IL-10R molecule**, such as IL-10R β as recited in claim 14,
 - B) To elect a method comprising a **modulator with specific characteristics, by electing the following sub-species:**
 - I) to elect a **specific molecule** said modulator binds to, such as IL-10R β , as recited in claim 14,
 - II) to specify if said modulator is an antibody, as recited in claim 15
 - III) to specify if said modulator is an agonist or an antagonist of said molecule, as recited in claims 16 and 17, respectively.
6. Applicant is required, in response to this action, to elect a specific species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.
7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.
9. The following claim(s) are generic: claims 1, 7 and 13.
10. The species are distinct each from the other because the methods comprise

different products which differ with respect to their physicochemical properties. Therefore they are patentably distinct.


11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

12. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.
Patent Examiner
Group 1640
Technology Center 1600
April 19, 2001


DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182 1644